

REMARKS**Status of Claims**

In this paper, claims 4, 6 and 43 have been amended. Support for the amendments to the claims can be found throughout the specification and claims as filed, e.g., at page 22, lines 17-22. Claims 17 and 18 have been cancelled without prejudice or disclaimer. No new matter has been added.

Claims 1-14, 21, 24, 25, 28, 29, 31, 32, 37-40, 42, 43, 46 and 47 are pending in the application, claims 4-9, 12, 13, 25 and 43 are under examination, and claims 1-3, 10, 11, 14, 21, 24, 28, 29, 31, 32, 37-40, 42, 46 and 47 stand withdrawn from consideration.

The amendments to the claims (or cancellation of claims) are being made for the purpose of expediting prosecution and are made without prejudice or waiver of any subject matter thereof. Applicants reserve the right to present the original claims in this or a continuing application. No new matter has been added.

Applicants note with appreciation the indication that claims 6 and 7 recite allowable subject matter. Claim 6 has been rewritten in independent form.

Rejection under 35 U.S.C. §112, first paragraph (enablement)

Claims 17 and 18 stand rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the enablement requirement. This rejection is traversed.

Without agreeing with this rejection, and to expedite prosecution and allowance of the present application, claims 17 and 18 have been cancelled without prejudice or disclaimer. The rejection is therefore moot. Reconsideration and withdrawal of the rejection is proper and such action is requested.

Rejections under 35 U.S.C. §102(b)/(e)

Claims 4, 5, 8, 9, 12, 13, 17 and 18 stand rejected under 35 U.S.C. §102(b)/(e), as allegedly anticipated by the Williams et al. reference (WO99/038972 or U.S. Patent No. 6,964,868). This rejection is traversed.

As an initial matter, as noted above, claims 17 and 18 have been cancelled, and the rejection is moot as to those claims.

Pending claims 4, 5, 8, 9, 12, 13 are directed to an isolated polynucleotide comprising a polynucleotide of SEQ ID NO:16, or a polynucleotide having at least 95% homology to the polynucleotide of SEQ ID NO:16 (claims 4-5); a pharmaceutical composition comprising such a polynucleotide (claim 12); a diagnostic agent comprising such a polynucleotide (claim 13); an isolated recombinant vector comprising such a polynucleotide (claim 8); or an isolated transformant transformed by the recombinant vector (claim 9).

As the Office Action appears to acknowledge (Office Action at page 10), the Williams reference does not disclose an isolated polynucleotide comprising the polynucleotide of SEQ ID NO:16, or a polynucleotide having at least 95% homology to the polynucleotide of SEQ ID NO:16. Thus, even if the Williams reference discloses “a partial sequence of the polynucleotide of SEQ ID NO: 16 with 99.3% local nucleotide identity” as stated in the Office Action, the Williams reference does not disclose an isolated polynucleotide as claimed in pending claim 4. The Williams reference also does not disclose vectors, transformants, pharmaceutical compositions, or diagnostic agents as presently claimed. Therefore, the Williams reference does not and cannot anticipate the pending claims.

Claims 4-5 and 17 stand rejected under 35 U.S.C. §102(b), as allegedly anticipated by the GenBank (EST) Accession No. BQ68095. This rejection is traversed.

As an initial matter, as noted above, claim 17 has been cancelled, and the rejection is moot as to that claim.

As the Office Action appears to acknowledge (Office Action at page 12), the GenBank reference does not disclose an isolated polynucleotide comprising the polynucleotide represented by SEQ ID NO:16, or a polynucleotide having at least 95% homology to the polynucleotide represented by SEQ ID NO:16. Therefore, the GenBank reference does not and cannot anticipate the pending claims.

Reconsideration and withdrawal of the rejections is proper and is requested.

Rejection under 35 U.S.C. §103(a)

Claims 25 and 43 stand rejected under 35 U.S.C. §103(a), as allegedly unpatentable over the Williams et al. reference in view of Croce et al., U.S. Patent No. 5,928,884. This rejection is traversed.

Pending claim 25 is directed to a kit for screening a compound or its salt inhibiting the expression of a gene, the kit comprising the polynucleotide according to claim 4 (i.e., a polynucleotide comprising the polynucleotide of SEQ ID NO:16, or a polynucleotide having at least 95% homology to the polynucleotide represented by SEQ ID NO:16). Pending claim 43 is directed to a kit for screening a prophylactic/therapeutic agent for a cancer, the kit comprising an isolated polynucleotide comprising the polynucleotide of SEQ ID NO:16, or a polynucleotide having at least 95% homology to the polynucleotide of SEQ ID NO:16.

The disclosure of the Williams reference has been discussed above. The Croce reference is cited in the Office Action only for teaching a “diagnostic kit comprising a DNA probe as an active ingredient.” In view of the differences between the Williams reference and the subject matter of claims 25 and 43, the Williams reference cannot render obvious claims 25 and 43 (and the Office Action does not suggest otherwise). Applicants contend that the Croce reference – which also does not disclose a polynucleotide comprising the polynucleotide of SEQ ID NO:16, or a polynucleotide having at least 95% homology to the polynucleotide represented by SEQ ID NO:16 - cannot “bridge the gap” between the teachings of the Williams reference and the subject matter of the pending claims. The statement in the Office Action regarding “the polynucleotide of the primary reference by Williams et al., comprising full or partial sequence of SEQ ID NO: 16” is not relevant to the pending claims.

Because neither the Williams reference nor the Croce reference, alone or in combination, render obvious any pending claim, the rejection cannot stand and should be withdrawn.

Rejections under 35 U.S.C. §112, first paragraph (enablement)

Claims 4, 5, 8, 9, 12, 13, 17, 18, 25 and 43 stand rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the enablement requirement. This rejection is traversed.

As an initial matter, and as noted above, claims 17 and 18 have been cancelled without prejudice or disclaimer. The rejection is therefore moot as to these claims.

Further, Applicants note with appreciation the acknowledgement (Office Action at page 14) that the specification is enabling for a polynucleotide comprising the polynucleotide of SEQ ID NO:16 (and a vector, transformant, pharmaceutical composition, and diagnostic kit comprising the same).

Without agreeing with the rejection, Applicants note that the amended claims (e.g., pending claim 4) recite a polynucleotide comprising the polynucleotide of SEQ ID NO:16, or a polynucleotide having at least 95% homology to the polynucleotide of SEQ ID NO:16. Thus, the statement in the Office Action that “[t]he instant claims are broadly drawn to polynucleotides comprising a (any) polynucleotide SEQ ID NO: 16 or a (any) polynucleotide having at least 80% homology to the polynucleotide of SEQ ID NO: 16” does not apply to the pending claims.

Applicants respectfully submit that one of ordinary skill in the art could readily make and use a polynucleotide having at least 95% homology to the polynucleotide of SEQ ID NO:16 (or a vector, transformant, pharmaceutical composition, and diagnostic agent or kit comprising the same) without undue experimentation. Applicants further contend that one of ordinary skill in the art could make and use the claimed polynucleotides, vectors, transformants, pharmaceutical compositions, diagnostic agents, and kits according to the pending claims using no more than routine experimentation. As the Office Action acknowledges, all that is required is that “reasonable correlation must exist between the scope of the claims and the scope of enablement set fort[h]”. That is clear the case for the instant claims.

Reconsideration and withdrawal of the rejection is proper and such action is requested.

CONCLUSION

Early and favorable consideration of the application is earnestly solicited.

If the Examiner considers that obstacles to allowance still exist, the undersigned invites the Examiner to contact him at the telephone number given below.

Applicants conditionally petition for any extension of time required. The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 04-1105, under Order No. 62936 (46342).

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Respectfully submitted,

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